

### REMARKS

Reconsideration of this Application is requested.

In the Declaration and Power of Attorney signed September 19, 2000 and September 23, 2000, Applicants included the following statement "we will surrender said Patent upon notice of allowability of the subject application".

The Examiner indicated that the amendments filed on July 28, 2000 and August 6, 2001, do not conform to 37 CFR §1.173; 37 CFR 1.121(b)(1)(i); 37 CFR §1.121(b)(1)(ii); 37 CFR §(1.121(b)(2)(I)(A); 37 CFR §1.121(b)(2)(i)(C); 37 CFR §1.121(b)(2)(iii); and 37 CFR § (1.121(b)(6)

Applicants have amended the specification and claims to overcome the above.

The Examiner has objected to the disclosure, because it is confusing on page 8, lines 22-24. The disclosure has been amended to indicate that the input to step 376 comes from C5.

The Examiner has objected to the August 6, 2001, Amendment under 35 USC §132, because it introduces new matter into the disclosure. The Examiner is of the opinion that the disclosure as originally filed does not provide support for using permit mail. In the summary of the invention at page 2, lines 39-43, Applicants stated:

"Once the document has been printed, the document is inserted into the envelope by inserting means to form an unfinished mail piece. The unfinished mail piece is sealed and then franked with appropriate postage in order to form a finished mail piece."

On page 4, lines 7-17, the issued patent application states:

"At step 118, the printed document is merged with the printed envelope to create an unfinished mail piece. From step 118, the method advances to step 120 where the unfinished mail piece is franked with appropriate postage by a postage meter and then placed into the mail stream at step 122".

The addition of the expression "if it is not permit mail or mail having a postage stamp" after the word "franked" in the above two paragraphs is not new matter. One skilled in the postage art knows that the USPS requires postage to be applied to a finished mail piece that will be accepted by the USPS. Postage may be paid by affixing a stamp to the mail piece, affixing a postal indicia to the mail piece with an approved postage meter, or by permit mail.

The United States Postal Service "Glossary of Postal Terms", Publication No. 32, Pub. May 1997, defines the terms "permit" and "permit imprint" on page 83 as follows:

**"permit** - Any authorization required for specific types of preparation or postage payment. Specifically, an authorization to mail without postage affixed by using indicia or an imprint. Payment is made against an advance deposit account that is established with the USPS for postage and services.

**permit imprint** - Printed indicia, instead of an adhesive postage stamp or meter stamp that shows postage prepayment by an authorized mailer. (Also see *permit*)."

This Amendment adds the expression "or mail having a postage stamp" so that the new added expression in the above paragraph reads "...If it is not permit mail or mail having a postage stamp" to the paragraph mentioned on page 2 and page 4. Applicants are just clarifying the application by listing ways to pay for postage, which is well known to those having ordinary skill in the art.

See *Chisum On Patents* Vol. 4 §11.04[2][a] which reads as follows:

**[a] - Clarifications.** Court decisions state, in various ways, that specifications may be amended to "clarify" the original disclosure; thus: (1) "insertions by way of amendment in the description or drawing, or both, of a patent application do not invalidate the patent, if they are only in amplification and explanation of what was already reasonably indicated to be within the invention"; (2) "amendments may be made to patent applications for the purpose of curing defects, obvious to one skilled in the art, in the drawings or written descriptions of inventions"; (3) "an amendment to an application is not 'new

matter' within the Patent Act or Rules of the Patent Office unless it discloses 'an invention, process or apparatus not theretofore described.'...If the later-submitted material accused of being 'new matter' simply clarifies or completes the prior disclosure it cannot be treated as 'new matter.'...Moreover the determination of the Patent Office to admit the later-submitted material accused of being 'new matter' simply clarifies or completes the prior disclosure it cannot be treated as 'new matter.'...Moreover, the determination of the Patent Office to admit the later-submitted material, thereby signifying that the Patent Office does not consider it to be 'new matter,' is presumptively correct.", (4) "the amendments to the specification merely render explicit what had been implicitly disclosed originally, and, while new language has certainly been added, we are not prone to view all new 'language' ipso facto as 'new matter.' "..."

The Examiner has objected to the specification and claim 51 under 35 USC §112 as not providing support for the invention as now claimed. The Examiner is of the opinion that the use of permit mail is new matter. For the reasons mentioned above, the use of permit mail is not new matter.

Claims 20, 24, 28-39 and 43-47 have been rejected by the Examiner under 35 USC §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Examiner is of the opinion that claims 20, 24, 28-39 and 44-47 fail to recite that the item of mail is franked and, hence, is not a finished mail piece as the instant invention is intended to produce.

In claim 20 and those claims dependent thereon, Applicants are claiming a method for producing a mail piece. The mailer may pay the postage for mailing the mail piece by affixing a stamp to the mail piece, affixing a permit imprint to the mail piece, or affixing a postal indicia to the mail piece with an approved postage meter. Thus, claim 20 and those claims dependent thereon are not indefinite. Claim 20 and those claims dependent thereon are not inoperative, since a mail piece does not have to be franked to be a finished mail piece. The mail piece may be permit mail or stamped mail.

The Examiner was not able to determine the scope and meaning of claim 43, since claim 43 did not conform to the requirements of 37 CFR §1.173; 37 CFR §1.121(b)(2)(i)(A); 37 CFR §1.121(b)(2)(i)(C); 37 CFR §1.121(b)(2)(iii); and 37 CFR §1.121(b)(6). Claim 43 has been completely underlined to comply with the above regulations.

Claims 1-4, 6-12, 15-36, 38-46 and 48-50 have been rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Cordery, et al (U.S. Patent No. 5,628,249) or Harman, et al. (U.S. Patent No. 5,684,706), or Baker, et al. (U.S. Patent No. 5,067,305) or Murcko, et al. (U.S. Patent No. 5,476,255) in view of Humes, et al. (U.S. Patent No. 5,377,120) and common practice.

Cordery discloses the following in column 1, line 64 to column 2, line 14:

"...an apparatus and method for producing a mail piece, wherein the apparatus includes a first printer for printing a document and a mail finishing unit for receiving the document from the first printer and inserting the document into an envelope to form a mail piece. The mail finishing unit includes a second printer for printing an address on the envelope prior to insertion of the document into the envelope. The apparatus also includes a controller which is responsive to mail piece data; the mail piece data including first data for defining the document and second data for defining the address to be printed on the document. In accordance with the method of the subject invention the document is printed in the first printer and the envelope is printed with the corresponding address in the second printer prior to insertion of the document into the envelope and the printed document and printed envelope are fed along separate paths to an inserter where the document is inserted into the envelope."

Harman discloses the following in column 1, line 66 to column 2, line 14:

"...a system including a plurality of apparatus for producing a mail piece, wherein the apparatus each include a first printer for printing a document and a mail finishing unit for receiving the document from the first printer and combining the document with an envelope to form a mail piece. The mail finishing unit includes a mechanism for franking the mail piece. The apparatus also includes a controller

which is responsive to mail piece data; the mail piece data including first data for defining the document and second data for defining the address to be printed on the document and postal data defining a postage value for the mail piece. The controller controls the first printer to print documents in accordance with the document data and controls the franking mechanism to frank the mail piece with the postage value."

Baker discloses the following in column 3, lines 1-16:

"...an apparatus which includes an input for input of information defining a mail piece configuration and sheet processing apparatus for accumulating sheets with an envelope form, folding the accumulated sheets and envelope form, and then sealing the envelope form to form the mail piece; where the folder sealer apparatus has a capacity to fold a predetermined maximum number of sheets. The apparatus of the subject invention also includes a control system for determining the number of sheets in the mail piece in accordance with the defining information and, if the number of sheets is less than the maximum, controlling the folder sealer apparatus in accordance with the defining information to form the mail piece in the configuration, and, if the number of sheets is greater than the maximum, aborting operation of the folder sealer apparatus without forming the mail piece."

Murcko discloses the following in column 3, lines 7-13

"...a means of a mechanism for feeding sheets from a stack which include a low force feed device for urging the top sheet of the stack forward, and a combined device for receiving the top sheet, corrugating the top sheet, singulating the top sheet from a following sheet which may have adhered to the top sheet and feeding the top sheet forward for further processing."

Humes discloses the following in column 2, lines 39-61:

"...a machine for lowering the mailing costs of small volume merchants by producing bundles for low postal rate mailings which are made up of the commingled pieces from a plurality of merchants. The machine comprises, in the preferred embodiment, a first computer operable to combine the mailing lists of a plurality of merchants and group the addresses on the mailing lists according to the lowers postal rate. The first computer is further operable to generate the address information required by postal regulations, such as bar codes or zip+4 numbers, for each address; and to further assign a merchant-identifier tag to each address thus creating a merged data base of the merchants' mailing lists. The first computer is further operable to generate documentation for the

post office as well as individual client invoices. A second computer serves as a sequence controller to operate mail piece handling machinery according to the grouped addresses. The present invention further comprises the mail piece handling machinery for physical commingling and addressing of the different merchants non-alike pieces."

The art cited by the Examiner does not disclose or anticipate, separately or together, the method and system of defining and producing the finished mail piece claimed by Applicants. Applicants claim a method and system that allow a user to select at a first node a plurality of characteristics that define a mailing. Once the selections have been made, the selected information is transmitted to a terminal node, wherein the terminal node is not under the control of the first node so that the terminal node may control the time of production of mail pieces. The terminal node may also direct the production of mail pieces to mail production means for producing the mail. Hence, the mail piece may be directed to specific mail production means so that mail pieces may be produced efficiently or produced at a site that is closer to the recipient of the mail piece. Thus, the mail piece may be delivered in less time since it may be produced at a site and subsequently mailed from a site that is closer to the recipient.

The art cited by the Examiner in claim 1 and those claims dependent thereon, does not disclose or anticipate steps d, e, and h of claim 1, namely,

- (d) transmitting said print job to a terminal node wherein said terminal node is not co-located with, nor under the control of, said first node;
- (e) receiving said print job at said terminal node, said terminal node for receiving said print job and for directing said print job to a mail production means for producing said mail piece, said mail production means further comprising:
  - (i) a first printer; and

(ii) a second printer;

Cordery, Harman, Baker, Murcko, or Humes, taken separately or together, do not disclose or anticipate claim 15 and those claims dependent thereon. The above references do not allow one to control the time for producing a mail piece at a mail production site that may be located close to the recipient of the mail piece to reduce the time for delivering the mail piece. Elements b, and c are not disclosed or anticipated by the above references:

(b) transmission means for transmitting said mailing to a second data processing means wherein said second data processing means is not co-located with, nor under the control of, said first data processing means;

(c) second data processing means for receiving said mailing and downloading said mailing to a plurality of printer means comprising a first printer and a second printer;

Claims 5, 37 and 47 have been rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over either Cordery, et al. (U.S. Patent No. 5,628,249) or Harman, et al. (U.S. Patent No. 5,684,706) or Baker, et al. (U.S. Patent No. 5,067,305) or Murcko, et al. (U.S. Patent No. 5,476,255) as modified by Humes, et al. (5,377,120) and in view of common practice.

Claim 5 is dependent on claim 1, and claims 37 and 47 include all of the limitations of claim 20. As previously mentioned, the cited art does not include the limitations of independent claims 1 and 20. Furthermore, the cited art does not disclose or anticipate a receipt that is indicative of a print job that is generated by a terminal node and transmitted to a first node as claimed in claim 5. The cited art does not disclose or

anticipate the manner in which claim 37 utilizes a terminal node to provide an indication to a first node that mail has been placed into the mail stream for delivery.

The cited art also does not disclose or anticipate a second data processing means that provides an indication to the first data processing means that mail has been placed in a mail stream for delivery.

Claims 13 and 14 have been rejected by the Examiner under 35 USC §103(a) as being unpatentable over Harman, et al. as modified by Humes, et al. and in view of common practice.

The cited art or general practice does not disclose a second node that makes the distribution based upon the availability of the second node as claimed in claim 13. The supplies available are not the only factor that has to be determined by the second node to make the distribution. The availability of the equipment to generate the mail piece must also be considered.

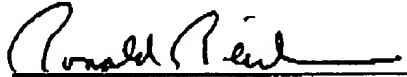
The cited art or general practice does not disclose or anticipate a distribution that is determined by the location of the terminal node as claimed in claim 14. This allows mail pieces to be produced at a site that is located closer to the recipient of the mail piece. Thus, the mail piece may be delivered in less time since it may be produced at a site and subsequently mailed from a site that is closer to the recipient. This is especially important to posts in the developing world where it takes a great deal of time to deliver mail between two regions of the country.

In view of the foregoing amendments and Remarks, it is respectfully submitted that claims 1-51 of this Application are now in condition for allowance, and favorable



action thereon is requested. Will the Examiner please call the attorney noted below to schedule a telephone conference to discuss this Application.

Respectfully submitted,



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**Version with Markings to Show Changes Made****In the specification:****Page 2, fourth full paragraph, line 42:**

Once the document has been printed, the document is inserted into the envelope by inserting means to form an unfinished mail piece. The unfinished mail piece is sealed and then franked if it is not permit mail or mail having a postage stamp with appropriate postage in order to form a finished mail piece. The mail piece is then placed into a mail stream for delivery to the destination address. A receipt indicative of the print job and delivery into the mail stream may be optionally generated by the terminal node and transmitted to the first node. A[n] feature available is the use of postal coding and duplicate detection as applied to the address list.

**Page 4, first full paragraph, line 15:**

At step 118, the printed document is merged with the printed envelope to create an unfinished mail piece. A number of different actions can be accomplished at this step. The printed media is manually or automatically inserted into the appropriate envelope, the envelopes can be stacked by stackers or redirected via transport means, weighed, and, the unfinished mail piece can be sealed by a sealer if required. From step 118, the method advances to step 120 where the unfinished mailpiece is franked if it is not permit mail or mail having a postage stamp with appropriate postage by a postage meter and then placed into the mail stream at step 122.

Page 8, third full paragraph, lines 24-25 and lines 34-35:

Turning to FIG. 5D, there is shown a series of selections that can be made to further define the parameters of the requested mailing. The method flow begins with a query at step 376[;additionally, path]. The input to step [376] 376 comes from C5 [coming from (FIG. 5C) re-enters the flow at step 376]. At step 376, the method queries as to whether or not the system operator wants to continue defining the mailing. If the response is "YES," then the method advances to step 386; otherwise, if the response to the query at step 376 is "NO," then the method advances to a query at step 378. At step 378, the method queries as to whether or not the system operator is done defining the mailing. If the response to the query is "NO," then the method advances to step 380 where the system user presses "CANCEL" and [any entries made in defining the mailing are not] erases only the data entered from the last point of saving while the rest of the entered data will be retained within the system memory. If the response to the query at step 378 is "YES," then the method advances to step 382 where the system user presses "DONE" to save the current entries. Both steps 380 and 382, advance to step 384 where the system returns the user to the Main Menu.

In the claims:

1. (Amended) A method of defining and producing a finished mail piece, comprising the steps of:
  - (a) selecting at a first node, a plurality of characteristics which together define a mailing;

- (b) creating a document and storing said document in electronic form[;], then directing that said stored document be included in a print job comprising said mailing;
- (c) creating an address list comprising one or more destination addresses and storing said address list in electronic form and then selecting said stored address list for inclusion in said print job;
- (d) transmitting said print job to a terminal node wherein said terminal node is not co-located with, nor under the control of, said first node;
- (e) receiving said print job at said terminal node[;], said terminal node for receiving said print job and for directing said print job to a mail production means for producing said mail piece[;], said mail production means further comprising:
  - (i) a first printer; and
  - (ii) a second printer;
- (f) printing on said first printer said destination address to an envelope wherein each of said destination addresses is printed to a corresponding envelope;
- (g) printing on said second printer said document, wherein said document is printed in accordance with characteristics selected at said first node;

(h) inserting said printed document into said printed envelope to form an unfinished mail piece;

(i) sealing said unfinished mail piece;

(j) franking said unfinished mail piece, in accordance with characteristics selected at said first node and with characteristics determined at said second node, in order to form a finished mail piece; and

(k) placing said finished mail piece into a mail stream for delivery to said destination address printed thereon.

3. (Amended) The method of claim 1, wherein said each of said destination addresses comprising said stored address list is compared to a predetermined database of correct addresses wherein each address is matched with a corresponding zip code[;], and, if said each of said destination addresses does not match said correct address then said non-matching address is corrected to match said correct address.

18. (Amended) The system of claim 15, wherein said system further comprises a plurality of nodes wherein one node is an initiating node and a second node is a terminal node[;], and, if there are more than two nodes in said system, then said first and said second printer means are located at said terminal node.

38. (Amended) A system for producing a mail piece, comprising:

first data processing means for selecting a document, selecting an address list including one or more destination addresses, and selecting a plurality of characteristics which define a mailing;

second data processing means for receiving said selected document, address list and characteristics and directing said selected document, address list and characteristics to a mail production means, wherein said second data processing means is not co-located with, nor under the control of, said first data processing means;

said mail production means comprising first means for printing said selected document in accordance with one or more of said selected characteristics, second means for printing each of said destination addresses to a corresponding envelope, and means for inserting said printed document into a corresponding printed envelope.

43. (Amended) A system according to claim 38, wherein said document and said address list are stored in electronic form.

48. The method claimed in claim 1, wherein in step (h), the destination address information on said document matches said destination address on said envelope if said document contains specific address information.

49. The system claimed in claim 15, wherein said destination address information on said document matches the destination address on said envelope if the document contains specific address information.

50. The method claimed in claim 20, wherein said destination address information on said document matches said destination address on said envelope if said document contains specific address information.

51. The method according to claim 22, wherein said evidence of postage is a permit mail postal indicia.